Applicant's revised Claims 12 through 22, as amended, cover an insurance verification method using all available data, whether complete, accurate, interrelated, or repetitive from three data sources: insurance companies, state motor vehicle records, and state driver's license records. This data is not pre-screened by category (added claim amendment). It also does not necessarily contain corresponding cross-matching interrelated data field categories for common indexing (added claim amendment). The Examiner initially refused entry of the amendment on the grounds that they raised new features that required a new search. A request for Re-Examination was subsequently filed, the amended claims entered, and the additional search conducted. The present Office Action was then issued rejecting the amended claims without reliance on any newly discovered references.

Revised Claims 12 through 22 eliminate the need for extensive personnel screening training and insures more than sufficient data input to generate highly accurate automobile insurance verification lists. Applicant's employment of all available data without pre-screening or common indicia indexing, whether accurate or not, to provide highly accurate lists of drivers having automobile insurance is counterintuitive to the problem being solved. It is not disclosed in the Garret reference (U.S. Patent No. 5,325,291 in Class 364/401 and 409) cited by the Examiner. Garrett utilizes two data bases:

1) a State provided database wherein the license plate/tag for a particular registered vehicle also includes the driver's license number, registrant's social security number and the insurance policy number (Col 2, lines 54-68, Claim 1, elements a, b, c, Col 5, lines 44-48), and

2) an insurance company provided database including pre-selected, generally identical data fields (Col 3, lines 7-11). As disclosed in Claim 1, elements d, e, f, and g, Col 5, lines 49-57, a portion of this insurance information is then selected "for use as an index key corresponding to said selected index key in said vehicle record". Key indexed data in both Garrett databases provides non-random correlated data, which materially affects the types of statistics and sampling employed to generate an uninsured motorist database. Random statistical sampling, similar to that included in applicant's Claim 15 method to check the accuracy of the uninsured motorist lists, is not employed by Garrett. Garrett's databases contain related data inputs. Consequently Garrett only employs cross-matching techniques. Garrett is thus only employed in States wherein the vehicle and insurance data fields have cross-matching data indices. This type of cross matched vehicle and insurance data fields is not present in many

states, and provides a type of pre-screened data input, which is then comparison matched to generate a list of uninsured motor vehicles. As such, it is subject to garbage in/garbage out comparisons, which are not statistically as accurate as applicant's method.

Garrett's two cross-matched data fields require comparison matching, and cannot be statistically improved via the employment of the May et al statistical methodology (May, Jerrold H. "A hybrid system improves claims auditing at Blue Cross", Interfaces, Providence, November/December 1993), which most likely would be catalogued in class 705/2 (See affidavit of Richard Kasteller, previously submitted). As discussed below, May is a plan performance evaluation management tool, and does not provide improved lists of uninsured motor vehicles. May generates health plan performance indices, which do not improve data inputs. Applicant's method employing three databases is therefore not disclosed or suggested by Garrett and May. The rejection of Claim 12, as amended, should be withdrawn as it is not in accordance with MPEP Section 2142.

According to MPEP Section 2142,

> To establish a prima facia case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Garrett does not address or disclose entering data input from three independent databases, which include repetitive, incomplete and inaccurate data, which is not pre-screened or necessarily cross-indexed. It therefore does not disclose or suggest applicant's computer processing method, which generates uninsured motorist and vehicle databases with in excess of 95% reliability. The Garrett reference is a computer matching system, which operates by cross-matching the data from two databases whose elements have similar indexing categories and assumes the accuracy of at least one of the inputted databases for comparison purposes. The Garrett interdependent databases provided by the State include cross-matched insurance policy numbers collected and included with the vehicle data at the time of registration of a vehicle for subsequent matching. It is therefore subject to "garbage in/garbage out" types of errors and can only provide corresponding matches to approximately 70% of the database (see page 2 of Applicant's Summary of the Invention disclosure discussing database errors in VIN numbers,

names and address abbreviations, or listings differently in submittal data lists, or the format of data differences, which result in a large number of matching errors in the Garrett type of corresponding matching systems). Conversely, applicant's system data is not necessarily interdependent and cross-indexed by common indices. It also assumes the unreliability of all raw input data from three separate databases. Applicant's method inputs all relevant data from multiple sources, whether accurate or not, and incorporates multiple algorithms as part of the process to generate uninsured motorist and vehicle databases with in excess of 95% reliability. It therefore is a "garbage in/reliable data out" type of processing system of suitable reliability for law enforcement field action to apprehend uninsured drivers.

The May Hybrid System for auditing Blue Cross health claims does not disclose applicant's computer processing method used to generate uninsured motorist databases, which have in excess of 95% reliability. May did not modify the existing health claims computer matching technology employed by the Blue Cross and Blue Shield Plans' information systems group (May, First Column, page 73). Instead, it is a computer-based support tool merging normative and descriptive techniques in response to a complex and constantly changing task environment that was not conducive to model formulation (May, Conclusions, p. 78). By setting aside existing software and focusing on end-user and task requirements, it provided a hybrid computer-based support tool to improve the efficiency and effectiveness of the auditing task (May, Conclusions, pp 78-79). It ... "allows a user to interactively explore how each health care plan or group has performed in a processing cycle. The user can traverse several paths of inquiry, viewing how groups perform relative to a particular plan, which errors are associated with a particular plan, which of the plan's errors came from a specific IPDR processing step, and so on." (2nd column, page 73). "The raw data series itself is used in analyzing the percentage fields and the months-suspense-file field. These fields indicate the quality of a plan's performance by showing the ratio of the claims suspended (that is, not paid) to those submitted on a monthly basis, analogous to an inventory concept, as well as the total number of claims suspended for each plan. For the dollar-volume-submitted, dollar-volume-rejected, number-of-records-submitted, the number-of-records-rejected fields, PlanTracker[May] first adjusts the field value for the number of days that have elapsed since the plan last submitted data (2nd column, page 75). Sums necessary for the regression and estimation are stored in the history file; the actual data values are not retained." (bottom of column 1 through top of column 2 on page 75).

Thus May does not generate lists of non-insureds. It is simply a plan evaluation program using statistical methods to provide management indices to track a health plan's performance and shortcomings to aid in management adjustments, and has nothing to do with the uninsured motor vehicle verification industry. Nor does it generate lists on uninsured motorists. The Garrett and May references therefore fail to separately suggest applicant's method of Claim 12.

Nothing in the May and Garrett references themselves suggest combining them in the manner suggested by the Examiner. The Examiner's suggested combination is in clear violation of *In re Sang-Su Lee*, No. 00-1158 decided January 18, 2002 by the US Court of Appeals for the Federal Circuit, requiring objective evidence that something in the references themselves suggests combining them in the manner proposed by the Examiner; citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). The uninsured motor vehicle verification industry is not the same as the health insurance claims processing industry. Their databases are different and involve different statutes, technologies, insurance codes, processing sequences, reviews, and claims assessment. Nothing in the references themselves establishes that these methods are analogous. Therefore, these dissimilar references in different art groups cannot be combined in the manner suggested by the Examiner where there is nothing in the references themselves, which suggests their combination.

More particularly, the health industry medical review sequence of the data input as well as co-payment verification is missing in the motor vehicle insurance verification industry. Nor is there any health industry requirement to cross check vehicle information against drivers. Such dissimilar industry practices teach away from combining these dissimilar methodologies. Therefore, where the examiner has admitted in the last Office Action that all insurance is not the same, but dependent upon contracts, industry specific probabilities and statutes and regulations, the Examiner must present evidence that these arts are analogous to combine references to suggest applicant's method.

Insurance claims processing is highly dependent upon the databases and industry objectives; hence the reason for different patent classifications. The Examiner has made sweeping unsupported statements justifying the combination of the May and Garrett references that "all insurance shares this common basic structure, and they further share the same problems of inaccurate, incomplete and repetitive data [so that] they are analogous art." This position is directly contradicted by the accompanying affidavit of Richard Kasteller. Mr. Kasteller has had

years of experience in the automobile insurance verification industry and indicated on page 8 of his affidavit that the May health insurance claim procedure and the Garret motor vehicle verification involve different industries with different databases, insurance codes, processing sequences, reviews, objectives, and claims assessment and therefore are not analogous. Where these references in different classifications contain no suggestion for combining the same, their combination to reject Claims 12-22 is improper and should be withdrawn.

Nor is the method of Claim 12, as amended, disclosed in the knowledge of persons of ordinary skill in the art and is therefore novel. According to MPEP Section 2143.01, the prior art must suggest the desirability of the claimed invention.

> "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998).

Nothing in the Garrett (Patent No. 5,325,291 or May et al suggests applicant's method processing all available information, including inaccurate information, from three separate, independent data bases. Nor is there anything in the rest of the automobile insurance verification art, which suggests applicant's approach; as a search of the PhD thesis Web site www.uni.com for the period 1999 to the present produced no other references than those cited by the Examiner. Consequently, where the Examiner has not identified the level of ordinary skill in the art of a practitioner who would be aware of applicant's method, and a search of the PhD art fails to disclose applicant's method more particularly described in the above amended claims, no prima facie case of obvious as to the level of skill in the industry has been established to reject the method of Claim 12. As such, Claim 12, as amended, is not suggested by the prior art and the Examiner's 35 USC §103(a) obviousness rejection as being unpatentable over Garrett (U.S. Patent No. 5,325, 291 in class 705/4) in view of May et al (May, Jerrold H. "A hybrid system improves claims auditing at Blue Cross", Interfaces, Providence, November/December 1993) should be withdrawn.

As Claim 12, as amended is not suggested or anticipated by the references, Claim 13 dependent thereon is not anticipated by either the Garrett or May references. These references fail to disclose Claim 13's required percentage quantities of matching of 96 percent, quality of computer matches of 99 percent, and an overall system reliability uninsured motorist database of 95.8 reliability. Only the May reference mentions percentages. May states, "Since 1987 a dollar

volume of claims rejected annually has decreased from 10 percent to 4.5 percent."(bottom, page 67). This May health group performance statistic has nothing to do with the percentage reliability of individual matching. The Examiner has thus failed to objectively support the rejection of renumbered Claim 13, as amended, and the rejection should be withdrawn. Specifically, the Examiner's citations of May, page 68, col. 2, paragraph 2, page 71, col. 1, lines 1-3 and page 72, col. 1, lines 1-4 refer to edit checks on the IPDR (interplan data reporting records) system reporting methods and patterns that result in inaccurate information, not the individual evaluation of all the individual listed claims. May is a management performance evaluation tool to determine overall efficiencies of the participating plans in the Blue Cross claims processing system. It generates statistical indices to evaluate plan performance. It therefore fails to generate accurate matching lists of the motor vehicle insurance data from three independent sources in a similar fashion as applicant's method. The rejection of Claim 13, as amended, should therefore be withdrawn.

As Claim 12, as amended is not suggested or anticipated by the references, Claims 15 (adding statistical sampling thereto), and 16 (adding generating lists of uninsured motorists dependent thereon) is not anticipated by either the Garrett or May references. The rejection of Claims 15 and 16, as amended, should therefore be withdrawn.

With respect to Claim 14, its rejection was based on the Garrett and May references and further in view of the New York State Department of Motor Vehicles (Anonymous, "Motor Vehicle Liability Insurance Reporting Implementation Guide", Version 1.0, April 1999). This New York reference also fails to provide any of the deficiencies with May and Garrett references discussed above. New York State Department of Motor Vehicles is an EDI Exchange Process (Page 8) wherein an insurance company or services agent sends an electronic file in X12 format containing sets of transactions. Upon receipt by the New York State DMV, the transactions are translated, and the following error scenarios are generated:

Required segments missing

Required data elements missing

Data elements are invalid: (incorrect number of characters, incorrect value according to the specification as outlined in the guide)

New York State Department of Motor Vehicles therefore does not manipulate data input from three independent sources to determine the overall reliability of the lists of uninsured motorists in

a manner similar to applicant's method. Nor is there anything in the New York reference itself, which suggests combining it with Garrett and May. The rejection of claim 14, as amended, based on the Garrett/May and the New York State combination of references should therefore also be withdrawn.

The rejection of Claims 17 (providing on-line real time computer display of the Claim 12 working database of uninsured motorists) and 18 (mailing notices requesting insurance verification and updating of the Claim 12 working data base); 20 (a method in excess of 95% matching of uninsured motorists from three data sources providing on line real time computer display, issuing notices requesting verification, and computer generating trend reports); and 21 (an apparatus computer generating in excess of 95% statistical matching of uninsured motorists from three data sources), as amended, as being unpatentable over Garrett and May as applied to claim 12 above, and further in view of Johnston (Johnston, Michelle Dally, "State Targets Scofflaw Drivers Database to Reveal Who is Insured") is also traversed. Johnston is an article indicating that Colorado will be utilizing on-line computer lists of uninsured motorists. It does not disclose or provide any of the deficiencies discussed above with the May or Garrett references.

Nothing in the Garrett, May and Johnston references themselves suggests combining them in the manner suggested by the Examiner. Nor does Johnston supply any of the deficiencies of base Claim 12 employing a methodology using three independent databases. The real time access to the method of renumbered Claim 17 dependent on base claim 12 is therefore not suggested by these references and the rejection should be withdrawn.

Nor is the mailing verification method of renumbered Claim 18 dependent on the methodology using three independent data bases required of base claim 12, as amended, suggested by these reference. The Garrett, May, or Johnston references do not disclose data being updated with input from motorists. The Examiner has therefore provided no support for the obviousness rejection of Claim 18, and therefore the rejection should be withdrawn.

The rejection of Claim 9 (renumbered Claim 20) is traversed. Claim 20's in excess of 95% matching of three independent databases is dependent upon base claim 12, which is not suggested by the Garrett, May, and Johnston references as discussed above. Therefore this rejection of Claim 20, as amended, is also improper and should be withdrawn.

The rejection of Claim 10 (renumbered Claim 21) is traversed. The Examiner has cited

no "means-plus-function" structure, which accomplishes applicant's apparatus functional steps to reject the claim. Claim 21 provides an apparatus for identifying uninsured motorists employing input means, storage means into which a database from three independent sources is inputted regarding motor vehicles, drivers, and insurance, along with a sorting and matching program to generate unininsured motorist lists in excess of 95 per cent of matching drivers/vehicle/policy, and displaying them via a computer display. As discussed above, Garrett, May, and Johnston do not provide these features. The rejection of Claim 21, as amended, is also improper and should be withdrawn.

The rejection of Claim 8 (renumbered Claim 19) (a method to computer generate and transmit trend report summaries of the uninsured motorists within a geographical area of Claim 12) is traversed. Claim 19 is dependent upon renumbered Claim 12, as amended. Its rejection as being unpatentable over the combined teachings of Garrett and May and further in view of Bosco (U.S. Patent No. 5,191,522 is improper. As discussed above, neither Garrett nor May disclose applicant's invention. Bosco et al. (U.S. Patent No. 5,191,522) discloses an integrated group insurance information storage processing and reporting system through integrated program-controlled data processing systems communicating with a group insurance account data bank). It does not supply any of the deficiencies of the May and Garrett references. The rejection of renumbered Claim 19 employed in combination with renumbered Claim 12, as amended, transmitting highly accurate reports of uninsured motorists outside of a closed system is therefore not suggested by these references, and the rejection should be withdrawn. Further, the Examiner has cited nothing in the Garrett and May references themselves, which suggest improving the ease of distribution of the uninsured motorist data.

The rejection of Claim 11 (renumbered Claim 22) dependent upon amended Claim 21 as being unpatentable over the combined teachings of Garrett, May and Johnston as applied to Claim 10 (renumbered Claim 21) and further in view of Deppa (U.S. Patent No. 5,732,198) is similarly traversed. Deppa et al, (U.S. Patent No. 5,732,198) discloses a printing system for printing a page of a document. Deppa does not disclose a computer apparatus, which generates highly accurate printed lists of uninsured motor vehicles as claimed in Claim 22. Claim 22 includes electronic signal transfer means to transmit coded electronic signals to a receiving translated, which converts the coded electronic signals generated by the apparatus of Claim 21 into printed reports of uninsured motorists. Garrett, May, and Johnston do not disclose the

apparatus of Claim 21. Nor do they disclose electronic signal transfer of coded signals to a translator that converts the coded electronic signals into printed reports. Nothing in these references suggests combining the same with the Deppa to provide these deficiencies. Therefore, the Examiner has improperly combined four references via hindsight reconstruction to reject renumbered Claim 22, as amended, and the rejection should be withdrawn.

In summary, the rejection of Claims 12 through 22, as amended, should therefore be withdrawn. Applicant's invention and method provided the first statistically accurate uninsured motorist lists, which are reliable enough to be accessed in real time on line for field detention of uninsured motorists. It therefore meets the unexpectedly improved properties not present in the prior art under *In re Dillon*, 919 F.2d 692-93 (16 USPQ21d at 190l) to establish non-obviousness. If the foregoing revised claims are not sufficient to allow said claims, a telephonic conference is requested with the Examiner.

Dated this 11th day of April 2003.

Marcus G. Theodore, Attorney for Applicant
Reg. No. 26,815
466 South 500 East
Salt Lake City, Utah 84102
(801) 359-8622

CERTIFICATE OF MAILING

I certify that I mailed a true and correct copy of the foregoing Third Amendment to Mail Stop Non-Fee Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, postage prepaid this 11th day of April 2003.